

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Patent Application Serial No.: 10/538,856
Attorney Docket No.: 026390-00028

REMARKS

The Office Action dated March 29, 2010 has been received and carefully noted. The above amendments and the following remarks are being submitted as a full and complete response thereto.

Claim 6 has been rejected and is pending in this application. Claims 3 and 4 stand withdrawn as directed to a non-elected invention. Applicants respectfully request reconsideration and withdrawal of all rejections.

Rejection Under 35 U.S.C. §102

Claim 6 is rejected under 35 U.S.C. §102(b) as being anticipated by Sumitomo Electric Industries, Ltd. (JP 8-165582 A). Applicants respectfully traverse this rejection as Sumitomo fails to teach each and every claimed feature of the claim.

For example, Sumitomo fails to teach at least the combination of features including: a component in a film forming equipment for forming a thin film on a substrate, the component having: a matrix material; a first means on said matrix material for forming a first local cell, when exposed to a cleaning liquid, with the matrix material so that a first local current flows from the matrix material thereby advancing dissolution of the first means at an interface between the first means and the matrix material and allowing the removal of a film layer of the thin film from the matrix material; and a second means on said first means forming a second local cell, when exposed to a cleaning liquid, so that a second local current flows from the second means thereby advancing dissolution of the first means at an interface between the first means and the

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second means and allowing the removal of the film layer of the thin film from the matrix material, as claimed in claim 6.

The Examiner broadly contends that, because Sumitomo discloses plating chrome “on a base matrix material of Cu, or Cu alloy” and a further gold plating layer on the chrome, this automatically encompasses the claimed means in claim 6. This is allegedly because this combination “would provide the claimed reactions when dipped in the cleaning liquid since they carry the same electrochemical properties as described above.”

Simply put, Sumitomo fails to disclose at least the combination of claimed features including, among other things, the means for forming the local cells claimed in claim 6. As stated in MPEP §2182:

Both before and after Donaldson, the application of a prior art reference to a means or step plus function limitation requires that the prior art element perform the identical function specified in the claim. However, if a prior art reference teaches identity of function to that specified in a claim, then under Donaldson an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function.

(emphasis added). Applicants respectfully submit that there is no disclosure or teaching in Sumitomo of a structure that “perform[s] the identical function” claimed in claim 6.

The Examiner appears to admit as much when he describes the claimed means as being present if the metals were “dipped in a cleaning liquid,” as described in the instant invention but absent from Sumitomo. In other words, the Examiner appears to admit that at least part of the claimed means is absent from Sumitomo by recognizing that no element of Sumitomo can “perform the identical function specified in the claim” (see quote from MPEP §2182 above) without at least the addition of cleaning fluid and

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the step of dipping the apparatus in the fluid. Therefore, the Examiner's own language in the rejection appears to inadvertently imply that Sumitomo fails to provide either of the claimed means according to MPEP §2182.

Moreover, the Examiner's rejection is simply not valid under anticipation as defined by 35 U.S.C. § 102(b). Even if the Examiner's statements with respect to the metallic layers of Sumitomo were valid (not admitted), clearly the Examiner admits in the above quotation that at least adding a "cleaning fluid" to Sumitomo is necessary to account for even one of the two claimed means in claim 6. No such cleaning fluid or alternative to the cleaning fluid is disclosed in Sumitomo. The Examiner is respectfully reminded of MPEP §2131 Anticipation which states, under the heading "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM":

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (emphasis added)

The Examiner cannot add the cleaning fluid and the dipping step to Sumitomo under 35 U.S.C. § 102(b).

Even if the Examiner were to change the rejection to modify Sumitomo under 35 U.S.C. § 103(a) by adding a cleaning fluid or equivalent, such would be impermissible. This is because the Examiner apparently relies upon the instant specification for the cleaning fluid. Such is the very definition of impermissible hindsight (see MPEP §2141.01(a)). More specifically, the Examiner may not use information from the Applicant's disclosure as a motivation to modify a reference.

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Yet, the Examiner argues that the addition of a cleaning fluid and the step of dipping an apparatus of Sumitomo in said cleaning fluid are “mental steps and since the cleaning liquid is not a part that makes up the component; they don’t carry patentable weight.” This contention, insofar as it is understood, is respectfully disputed. The Examiner appears to be saying that setting up an electrochemical cell is a mere “mental” activity. This allegedly “mental” activity requires the addition of at least one physical substance (i.e., the cleaning fluid) to Sumitomo and further performing a physical act on the apparatus of Sumitomo using that added physical substance (i.e., the dipping). The contention that adding a physical substance and performing a physical act can be done “mental[ly]” seems to contradict the laws of physical science as presently understood by the Applicants.

Moreover, the Examiner’s contention appears to imply that a rejection of a means-plus-function claim requires only teaching the “component” or structural aspects of such a claim even if such a component lacks the claimed means. Applicants respectfully reiterate that MPEP §2182 requires the prior art to teach the same “function,” not the same structure or “component.” If it were otherwise, a means-plus-function claim would be nothing more than an apparatus claim and the “means for” terminology would be superfluous. Moreover, there is no requirement in the MPEP dictating that “means-plus-function” is restricted to “components” or structural aspects and that acts, “mental” or otherwise, carry no “patentable weight.” In fact, MPEP §2181(I) includes an explanation of means-plus-function that explicitly includes “acts”:

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If the corresponding structure, material or acts are described in the specification in specific terms (e.g., an emitter-coupled voltage comparator) and one skilled in the art could identify the structure, material or acts from that description, then the requirements of 35 U.S.C. 112, second and sixth paragraphs and are satisfied. See Atmel, 198 F.3d at 1382, 53 USPQ2d 1231. (emphasis added)

Moreover, MPEP §2181(I) does not seem to distinguish between mental and physical acts.

Accordingly, Applicants respectfully request withdrawal of all 35 U.S.C. §102 rejections.

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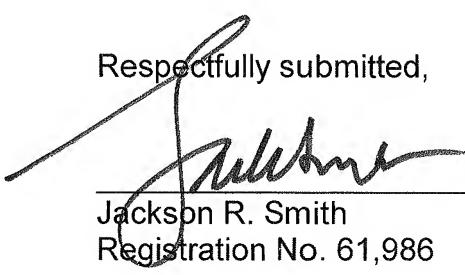
Conclusion

For all of the above reasons, it is respectfully submitted that the pending claims are in condition for allowance and a Notice of Allowability is earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is invited to contact the undersigned representative at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 referencing client matter number 026390-00028.

Respectfully submitted,


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